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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
THOMPSON, JAMES A	

ART UNIT	PAPER NUMBER
2624	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/847,843	OGINO, NOBORU	
	Examiner	Art Unit	
	James A. Thompson	2624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *01 May 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 September 2005 has been entered.

Response to Arguments

2. Applicant's arguments filed 12 September 2005 have been fully considered but they are not persuasive.

Regarding page 7, lines 8-22: *Applicant argues* that Yamazaki (US Patent 6,118,972) fails to disclose a countermeasure against the problem that the read size designated for the document on the document table is cancelled to read an image of another document which is fed by the document feeder. *Examiner responds* that Yamazaki discloses that "the document size detection for the second and subsequent document sheet is not conducted, and the size is regarded as the same as that of the first document sheet, and the automatic selection and keeping of the memory are conducted in the same manner as the first document sheet, and the image formation is continuously conducted" [column 10, lines 5-12 of Yamazaki, as cited on page 3 of the previous office action, dated 13 May 2005]. Tanaka (US Patent 5,973,797) teaches the document table and determining the document size on the document table, as set forth on page 7,

lines 3-18 of said previous office action. By combination, Yamazaki, Nishida (US Patent 5,961,226) and Tanaka fully teach the countermeasure argued by Applicant, said countermeasure corresponding to different limitations in the present claim.

Regarding page 8, line 1 to page 9, line 3: Nishida teaches the designation of the document size (column 4, lines 50-57 of Nishida) *via* a user interface (column 3, lines 1-4 of Nishida), as set forth on page 5, lines 1-11 of said previous office action. Yamazaki teaches reading a document according to a detected read size (column 9, line 63 to column 10, line 12 of Yamazaki). By combining Nishida with Yamazaki, the input of the document size, which is taught by Nishida, would correspond to the read size taught by Yamazaki.

Regarding page 9, lines 4-20: Tanaka discloses the document table. Thus, the combination of Yamazaki in view of Nishida *and Tanaka* fully teach the size detector for a document placed on the document table as specifically recited in claim 1.

Furthermore, Examiner has combined two separate elements of Nishida with Yamazaki, and thus provided two separate motivations. Applicant's summary does not detail the two combinations and motivations. Examiner specifically stated that "it would have been obvious to a person of ordinary skill in the art to include a user interface that allows the user to specify a document size and a read size if the document size is not recognized by the system, as taught by Nishida, wherein said document size detection is performed by the document size detector taught by Yamazaki. The motivation for doing so would have been that, if the document size cannot be determined by the system, a user should be able to input the data into the system, thus allowing the document processing to occur (column 4, lines

53-61 of Nishida). Otherwise, the system will not be able to process documents that are not a standard size." [page 6, lines 2-13 of said previous office action]. Thus, the ability to input document sizes, as taught by Nishida, is combined with the teachings of Yamazaki so that the system can process documents that are not a standard size. Examiner then goes on the explain that "it would have been obvious to a person of ordinary skill in the art to use the same independently specified document size for all the document images processed, as taught by Nishida. The motivation for doing so would have been to be able to process the plurality of document images faster (column 10, lines 5-9 and lines 12-17 of Yamazaki)" [page 6, lines 13-20 of said previous office action]. Claim 1 specifically recites "said read size specifying means is constructed such that the document size designated via said user interface is confirmed in a state where said cover is closed, and the document size *is maintained until said cover is opened*" [emphasis added] and "said reading unit is capable of reading an image of the other document fed by the document feeder while maintaining the document on the document table". Thus, while the cover is closed, the document size is maintained for all the other documents that are scanned.

Further, both in this section of Applicant's arguments and above, Applicant argues features, alleged advantages, and aims of the present specification. Applicant does not address specific claim language, but rather a summary of aspects of the present application. Thus, Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited

or the objections made. Further, they do not show how the amendments avoid such references or objections.

Regarding page 9, line 21 to page 10, line 14: Yamazaki, Nishida and Tanaka have been used in combination to fully teach the claimed invention. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, Applicant has not addressed the combination of references as has been presented in said previous office action, but has again relied on generalities.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yamazaki (US Patent 6,118,972) in view of Nishida (US Patent 5,961,226) and Tanaka (US Patent 5,973,797).

Yamazaki discloses a document reading device (figure 3 of Yamazaki) comprising a reading unit (figure 3(3) of Yamazaki) for reading an image of a document (column 8, lines 44-49 of Yamazaki); a document size detector (figure 3(S1) of Yamazaki) for detecting a size of the document (column 7, lines 15-20 of Yamazaki); a controller (figure 3(80) of Yamazaki) for

controlling said reading unit to read the image of the document in a read size corresponding to the document size (column 10, lines 5-12 of Yamazaki) confirmed from a detection result of said document size detector (column 9, line 63 to column 10, line 5 of Yamazaki), wherein said controller includes a user interface (figure 3(80("switches, numeral keys, and a liquid crystal touch panel")) of Yamazaki) for inputting various information (column 6, lines 20-24 of Yamazaki); and a document feeder (figure 1(2) of Yamazaki) for feeding a plurality of documents (column 6, lines 25-33 of Yamazaki). Yamazaki teaches that a user interface comprising switches, numeral keys, and a liquid crystal touch panel are a part of said controller (column 6, lines 20-24 of Yamazaki), though not specifically shown in figure 3 of Yamazaki.

Yamazaki does not disclose expressly that said user interface is used for outputting various information; that said controller includes read size specifying means for requesting designation of a document size via said user interface when the document size is not confirmable from a detection result of the document size detector and specifying the read size corresponding to the document size which is designated via said user interface according to the request; that said reading unit includes a document table for supporting a single document placed thereon and a cover capable of being opened and closed; that said read size specifying means is constructed such that the document size designated via said user interface is confirmed in a state where said cover is closed, and the document size is maintained until said cover is opened; that said reading unit is capable of reading an image of the other document fed by the document feeder while maintaining the

document on the document table; and that said read size specifying means is configured such that the read size for the document fed by said document feeder is independently specified from the read size for the document on said document table to maintain the document size designated via said user interface for the document on the document table when said reading unit is reading the image of the other document fed by the document feeder while maintaining the document on the document table.

Nishida discloses a user interface (figure 2(12,13) of Nishida) for inputting and outputting various information (column 3, lines 1-4 of Nishida). The keyboard (figure 2(12) of Nishida) and the crystal display (figure 2(13) of Nishida) constitute a user interface since both, in combination, are used to input and output relevant information (column 3, lines 1-4 of Nishida).

Nishida further discloses read size specifying means (figure 2(1) and column 3, lines 7-9 of Nishida) for requesting designation of a document size via said user interface (column 4, lines 50-57 of Nishida) when the document size is not confirmable from a detection result of a document size detector (column 4, lines 49-53 of Nishida) and specifying the read size corresponding to the document size which is designated via said user interface according to the request (column 4, lines 57-61 of Nishida); and that the read size specifying means is configured such that the read size for the document fed by a document feeder is independently specified by the user (column 4, lines 50-57 of Nishida) to maintain the document size designated via said user interface (column 4, lines 57-61 of Nishida). The system control unit (figure 2 (1) of Nishida) controls the sheet setting mechanism (column 3, lines 7-9 of

Nishida) based on the condition of the switches (column 4, lines 13-17 of Nishida). The switches, and their corresponding set condition, are a form of memory since the state of the switches is stored data which is modifiable based on changing conditions.

Yamazaki and Nishida are combinable because they are from the same field of endeavor, namely document size detection, document processing, and document printing. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to include a user interface that allows the user to specify a document size and a read size if the document size is not recognized by the system, as taught by Nishida, wherein said document size detection is performed by the document size detector taught by Yamazaki. The motivation for doing so would have been that, if the document size cannot be determined by the system, a user should be able to input the data into the system, thus allowing the document processing to occur (column 4, lines 53-61 of Nishida). Otherwise, the system will not be able to process documents that are not a standard size. Further, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the same independently specified document size for all the document images processed, as taught by Nishida. The motivation for doing so would have been to be able to process the plurality of document images faster (column 10, lines 5-9 and lines 12-17 of Yamazaki). Therefore, it would have been obvious to combine Nishida with Yamazaki.

Yamazaki in view of Nishida does not disclose expressly that said reading unit includes a document table for supporting a single document placed thereon and a cover capable of being opened and closed, and said read size specifying means is

configured such that the document size designated via said user interface is confirmed in a state where said cover is closed, and the document size is maintained until said cover is opened; that said reading unit is capable of reading an image of the other document fed by the document feeder while maintaining the document on the document table; and that said independently specified read size is specified from the read size for the document on said document table when said reading unit is reading the image of the other document fed by the document feeder while maintaining the document on the document table.

Tanaka discloses a document table (figure 1(16) of Tanaka) for supporting a single document placed thereon (column 7, lines 35-38 of Tanaka) and a cover (figure 1(24) of Tanaka) capable of being opened and closed (column 7, lines 57-62 of Tanaka), and that the document size is confirmed in a state where said cover is closed, and the document size is maintained until said cover is opened (column 18, lines 58-60 of Tanaka). The existence of a document (column 18, lines 52-57 of Tanaka) and the document size is only determined when the platen is in a closed state (column 18, lines 58-60 of Tanaka). Therefore, the detected document size is maintained until said cover is opened.

Tanaka further discloses reading a document on said document table and determining the document size (column 18, lines 52-57 of Tanaka); and specifying a read size from the read size for the document on said document table until the cover is opened (column 18, lines 58-60 of Tanaka).

Yamazaki in view of Nishida is combinable with Tanaka because they are from the same field of endeavor, namely document size detection, document processing, and document printing. At the time of the invention, it would have been

obvious to a person of ordinary skill in the art to include the document table and the cover taught by Tanaka as part of the overall reading unit and, when the read size specifying means designates a size via a user interface, as taught by Nishida, the document size is confirmed (determined) in a state where said cover is closed, as taught by Tanaka. The motivation for doing so would have been to be able to accurately determine the document size, regardless of the background color of the document (column 6, lines 11-20 of Tanaka). Furthermore, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the read size determined for the document on said document table, as taught by Tanaka, as the read size for all of the document images to be read and processed, as taught by Yamazaki in view of Nishida, since Nishida teaches that, when a document size is specifically determined, said document size is used for processing the document images (column 4, lines 42-46 and lines 57-61 of Nishida). The read size determined by the document table taught by Tanaka is simply used as the input. Thus, by combination, while the document is maintained on the document table and the cover closed, as taught by Tanaka, the reading unit taught by Yamazaki reads the image of the other document fed by the document feeder taught by Yamazaki. The motivation for doing so would have been that, by setting all the document sizes to a predetermined size (column 10, lines 5-9 of Yamazaki), the document image processing can be performed faster (column 10, lines 12-17 of Yamazaki). Further, since the document table taught by Tanaka is included as part of the reading unit taught by Yamazaki, and is thus separate from the document feeder taught by Yamazaki, then said document feeder feeds documents

other than the document on said document table and said reading unit is capable of reading an image of the other document fed by the document feeder while maintaining the document on the document table. Therefore, it would have been obvious to combine Tanaka with Yamazaki in view of Nishida to obtain the invention as specified in claim 1.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Thompson whose telephone number is 571-272-7441. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

18 November 2005

James A. Thompson
Examiner
Art Unit 2624

THOMAS D.